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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,712	11/18/2003	Jeffrey A. Davie	2968.255US02	6299

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EXAMINER

HESS, DANIEL A

ART UNIT PAPER NUMBER

2876

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,712

Applicant(s)

DAVIE ET AL.

Examiner

Daniel A. Hess

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

This is in response to applicant's reply of 11/23/04. The 'Response to Arguments' section below should be particularly helpful.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5-8 and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, each of these claims is based on a claim which recites the use of a 'PDL controller.'

However, PDL refers to 'page description language' while each of the above claims includes a limitation on writing to a smart card contact. There is a contradiction in that PDL relates to page layout including lines, arcs and text on the surface of the page, as well as arrangement and flow of sheets through a printer while data written into a smart card contact is none of these.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over article "PCL" in Webopedia in view of common desktop laser and inkjet printers, including Muratu (US 6,733,103).

Art Unit: 2876

Firstly, it is to be noted that the examiner is entitled to read claims 1 and 12 very broadly, because no specific features of the card printer are recited in these claims; to distinguish it from an off-the-shelf printer. [A “card printer” might broadly be construed as a printer capable of printing business cards, in which case an off-the-shelf HP laser printer from the time of the invention would teach the limitations of many of the claims.]

As the entry, “PCL” in Webopedia makes clear, PCL was developed by HP and is used by many laser and inkjet printers and is therefore multiplatform and standardized. Every printer has a data writer, namely a print head, and every PCL printer must have some kind of controller to translate the standard PCL output to signals that are relevant for the particular hardware that that printer has. Every printer has an external communication link.

Re claims 4, 15 and 16 specifically: Muratu teaches a color inkjet printer with multiple heads, i.e. one for each of the primary colors used.

For such a printer employing PCL, it is clearly necessary to coordinate between the different data writers in the manner recited in claims 4, 15 and 16.

Claims 9, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochizuki (US 2002/0001495) in view of Utsunomiya (US 2002/0097414).

Mochizuki teaches (see figure 1; whole spec.) the well-known configuration of a printer on an Ethernet.

While telnet control is not explicitly recited, Utsunomiya teaches [0008] that a printer on a LAN can have telnet access.

The motive for telnet access can be to sent custom low level commands to a printer.

Art Unit: 2876

As for the remainder of the limitations, these are generic to most printers and the applicant is referred to the discussion re claim 1 above.

Claims 10, 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klinefelter et al. (US 2002/0180993).

A card printer (title) is described. See figure 1: A hub, clearly internal and electrically integrated therein, is present. A plurality of different writers 24 are selectable by the hub, as is indicated. Data writers can [0018] be smart card encoders; see also 24D of figure 1.

Response to Arguments

The applicant's arguments with respect to claims 1-21 have been considered but are not persuasive. The examiner respectively clarifies his points of disagreement below.

The examiner's perspective is this: The term "card printer" is a very broad term which is not clearly defined in the claims. A "card printer" might broadly be construed as a printer capable of printing business cards, in which case an off-the-shelf HP laser printer from the time of the invention would teach the limitations of many of the claims.

There is no absolute set of capabilities that all card printers have, and thus claim 1 cannot be said to have any particular card printing capability unless that particular capability is explicitly recited.

The fact that many cards have a magnetic stripe or a smart card contact does not mean that the card printer of claim 1 must have capability to write these features because they are not

Art Unit: 2876

explicitly recited in the claim. In fact, although the applicant has argued on page 10 of the most recent response that cards are usually plastic, the card printer of claim 1 need not even be able to print onto plastic because that is not recited. As an aside, off the shelf printers have long been able to print onto clear plastic sheets used with projectors for presentations.

The examiner also observes that both of the terms PCL and PDL describe ways of communicating the layout of visual objects including text, lines and arcs as they are arranged on the page to a printer. In addition, they include other commands such as paper size, orientation, and certain drawing functions. These terms do not make clear sense when applied to information such as magnetic stripe data and data conveyed into a smart card chip, data that is not visually arranged on a surface. And without this non-visual data on the card (i.e. the magnetic stripe and the smart contact), in the examiner's view, there is really nothing distinguishing the card printer from a standard HP Laserjet TM off the shelf. A copy of the PCL specification is attached herewith; the examiner notes that magnetic stripe data and smart chip data nowhere appears as part of this specification.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2876

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DH

DANIEL STCYR
PRIMARY EXAMINER

